



# UNITED STATES PATENT AND TRADEMARK OFFICE

88

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,737	09/17/2003	Alan Phillips	PTG 02-103-13	4693
23531	7590	06/13/2005	EXAMINER	
SUITER WEST SWANTZ PC LLO 14301 FNB PARKWAY SUITE 220 OMAHA, NE 68154			TRUONG, THANH K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/665,737	Applicant(s) PHILLIPS ET AL.	
	Examiner Thanh K. Truong	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features:

“a universal adapter assembly” and “for pivotal coupling with the nail driving assembly” recited in claims 1, 15, 29 and 42;

“a driver blade” recited in claims 29 and 42;

“a lockout assembly” recited in claims 2, 16, 30 and 43;

“a trigger lockout assembly” recited in claims 3, 17, 31 and 44;

“a cover lockout assembly” recited in claims 5, 18, 32 and 45;

“a pick-off pivot assembly” recited in claims 6, 20, 33 and 46;

“an articulating pusher assembly” recited in claims 7, 21, 34 and 47;

“a nail checker assembly” recited in claims 8, 22, 35 and 48;

“a nail lockout assembly” recited in claims 9, 23, 36 and 49;

“a nail spacing verification assembly” recited in claims 10, 24, 37 and 50;

“a nail shank pawl assembly” recited in claims 11, 25, 38 and 51;

“a pinion nail verification assembly” recited in claims 12, 26, 39 and 52; and

“a clutch assembly” recited in claims 14, 28, 41 and 54;

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 3, 5-12, 14, 16-18, 20-26, 28, 30-39, 41, 43-52 and 54 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with

which it is most nearly connected, to make and/or use the invention. The following features:

- "a lockout assembly" recited in claims 2, 16, 30 and 43;
- "a trigger lockout assembly" recited in claims 3, 17, 31 and 44;
- "a cover lockout assembly" recited in claims 5, 18, 32 and 45;
- "a pick-off pivot assembly" recited in claims 6, 20, 33 and 46;
- "an articulating pusher assembly" recited in claims 7, 21, 34 and 47;
- "a nail checker assembly" recited in claims 8, 22, 35 and 48;
- "a nail lockout assembly" recited in claims 9, 23, 36 and 49;
- "a nail spacing verification assembly" recited in claims 10, 24, 37 and 50;
- "a nail shank pawl assembly" recited in claims 11, 25, 38 and 51;
- "a pinion nail verification assembly" recited in claims 12, 26, 39 and 52; and
- "a clutch assembly" recited in claims 14, 28, 41 and 54;

Although in paragraph [0020] these features are mentioned, there is no disclosure to explain or to describe the functioning of these features. Furthermore, there is no disclosure of "a clutch assembly".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 3, 5-12, 14, 16-18, 20-26, 28, 30-39, 41, 43-52 and 54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly

point out and distinctly claim the subject matter which applicant regards as the invention.

The following claimed features:

- "a lockout assembly" recited in claims 2, 16, 30 and 43;
- "a trigger lockout assembly" recited in claims 3, 17, 31 and 44;
- "a cover lockout assembly" recited in claims 5, 18, 32 and 45;
- "a pick-off pivot assembly" recited in claims 6, 20, 33 and 46;
- "an articulating pusher assembly" recited in claims 7, 21, 34 and 47;
- "a nail checker assembly" recited in claims 8, 22, 35 and 48;
- "a nail lockout assembly" recited in claims 9, 23, 36 and 49;
- "a nail spacing verification assembly" recited in claims 10, 24, 37 and 50;
- "a nail shank pawl assembly" recited in claims 11, 25, 38 and 51;
- "a pinion nail verification assembly" recited in claims 12, 26, 39 and 52; and
- "a clutch assembly" recited in claims 14, 28, 41 and 54;

are mentioned in paragraph [0020], but there are no explanations or descriptions of how these elements function, therefore, it is unclear what are the metes and bounds of the claims. Furthermore, there is no disclosure of "a clutch assembly".

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 3721

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 13, 15, 19, 27, 29, 40, 42 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6,431,428) in view of Hou (5,653,371).

Chen discloses an apparatus comprising:

a housing (20) including a first end, a second end and a top side, the housing for storing nails (50) and providing nails to the nail driving assembly of the nail gun;

an adjustment assembly (13, 22, 23, 132) disposed proximal to the second end of the housing, the adjustment assembly for affixing the position of the housing relative to the nail gun (column 1, lines 29-41);

a universal adapter assembly (the pivoting point to couple the magazine 20 and the barrel 16) coupled with the first end of the housing, the universal adapter assembly for pivotally coupling the nail driving assembly,

a cover including a first side, the cover coupled with the housing and for providing protection to the housing; and

an adjustable angle nose casting assembly (the barrel 16 assembly) couple with the nail driving assembly (10), the adjustable angle nose casting assembly for receiving the nail and enabling the operational engagement of the driver blade with the nail (column 2, lines 12-13);

Chen discloses the claimed invention, but does not expressly disclose a top loading mechanism disposed upon the housing (as in claims 1 and 29) and a side loading mechanism disposed on the side of the cover (as in claims 15 and 42).

Art Unit: 3721

Hou discloses an apparatus comprising: a top loading mechanism disposed upon the housing (figure 3, column 1, lines 33-34) and a side loading mechanism disposed on the side of the cover (figure 5, column 2, lines 60-61). Hou's mechanism enable the user a means to load nails to magazine either on top of magazine or on the side of the magazine providing flexibility to the nail gun.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Chen's apparatus by incorporating the top loading and the side loading as taught by Hou providing the nails loading flexibility to the hand tool.

Chen further discloses: a cover is removable from the housing (figure 1 shows that the cover of the housing is removable from the housing), and the nail gun is a pneumatic nail gun (abstract).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

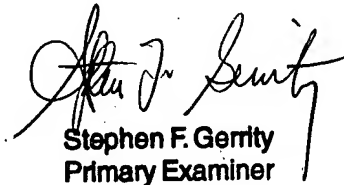
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt  
June 8, 2005.

  
Stephen F. Gerrity  
Primary Examiner  
571-272-4460